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530 7590 01/20/2010 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER SMITH, BENJAMIN J				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,153

Applicant(s)

BJORK, MAGNUS

Examiner

Benjamin J. Smith

Art Unit

2176

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/20/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's Response

In Applicant's Response dated 9/28/2009, Applicant amended Claims 1, 3-11, canceled claims 2, 12-14, added Claims 15-17, and argued against all objections and rejections previously set forth in the Office Action dated 5/28/2009.

Based on the amendments, the objections to the Specification previously set forth are withdrawn.

Based on the amendments, the objections to the claims previously set forth are partially withdrawn.

Based on the cancellation of the claims, the rejection of Claims 12-14 under 35 U.S.C. 101 previously set forth is withdrawn.

Based on the amendments, the prior art rejection of Claims 1-14 under 35 U.S.C. 103 previously set forth are withdrawn. (maintained)

The examiner appreciates the applicant noting where the support for the amendments is located in the specification.

Claims 1, 3-11 and 15-17 remain pending for examination. Claims 1 and 8 are independent claims.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the recited "digital copy" of Claim 1 and 8.

The Specification does not mention the recited "digital copy". Thus, there is no support or antecedent basis for the recited "digital copy" that allows the meaning of the term to be ascertained, as required in 37 CFR 1.75(d)(1).

The specification discloses a "structure corresponding to for example a physical form" (Page 9, lines 20-23 of the specification) not a "digital copy of a physical form". The applicant discloses a XML file as the digital overlay with elements that correspond to the physical form, but the term "digital copy" could literally mean a digital copy, such as a scanned image. Because the term is not defined in the specification it is objected to.

Claim Objections

Claim 1 is objected to because of the following informalities:

- the claim recites the limitation "information entity in dependence or each other" in lines 12-13. This wording is unclear as to whether the first and second information entity is **independent or dependant** of each other.

Claim 8 is objected to because of the following informalities:

- the claim recites the limitation "information entity in dependence or each other" in line 12. This wording is unclear as to whether the first and second information entity is **independent or dependant** of each other.
- Claim 4 should be amended to remove the dashes as follows:

The system according to claim 1, wherein the first information entity is an HTML

[[---]] file

Appropriate correction is required.

Examiners Interpretation of Claim 1:

For purposes of USC 101, the examiner has regarded the "communication terminal" as necessarily including hardware (see paragraph 0024 of the published specification). That is to say the "communication terminal" is interpreted as being hardware only or having hardware parts and not merely being software only.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Chalecki et. al. US Patent No. 7,451,392 (hereinafter, "Chalecki") in view of Daconta et. al. US Patent No. 7,299,408, (hereinafter, "Daconta") and further in view of John Patterson US Patent Publication No. 2005/006044 (hereinafter, "Patterson")

Claim 1:

Chalecki teaches:

A system for administering at least one electronic document, the system comprising [abstract]:

a communication terminal adapted for communication with a server via a network, the server being adapted for communication with a database [col. 5, lines 13-22 and col. 3, lines 49-57] comprising at least a first information entity and a second information entity [col. 7, lines 14-32] [one file contains many files, including XML and HTML],

...

wherein the communication terminal displays the first and the second information entity in dependence of each other such that they form the electronic document, and to provide user-generated information provided by a user of the communication terminal to the second information entity [col. 7, lines 34-59] [data files packaged together "in dependence" of each other, user generated information is the information the user enters into the form], wherein

Chalecki fails to teach:

the first information entity including a framework comprising a digital copy of a physical form, and the second information entity includes an overlay having predefined form fields corresponding to the structure of the framework,

...

wherein the communication terminal generates a third information entity comprising information corresponding to at least parts of the framework and overlay of the first and second information entity and the user-generated information by a converter,

wherein the communication terminal is adapted to make the third information entity unique, and

wherein the server is adapted to transmit at least a part of the unique third information entity to a receiving unit.

Daconta teaches:

wherein the communication terminal generates a third information entity comprising information corresponding to at least parts of the framework and overlay of the first and second information entity and the user-generated information by a converter [col. 4, lines 14-45] [first, second and third parts are described as shown in the figure, the multiple parts to the document described could be the parts described in Chalecki as well, only with the addition of a signature portion], wherein

wherein the communication terminal is adapted to make the third information entity unique [col. 10, line 43 – col. 11, line 36] [add signature to document, where the signature is unique to the document], and

wherein the server is adapted to transmit at least a part of the unique third information entity to a receiving unit [col. 4, lines 46-59] [document can be separated or stripped and transmitted].

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method of document display and form creation in Chalecki with the method of form validation and digital signatures in Daconta.

This combination would have been useful to allow the user the ability to sign documents electronically.

Chalecki and Daconta fail to teach:

the first information entity including a framework comprising a digital copy of a physical form, and the second information entity includes an overlay having predefined form fields corresponding to the structure of the framework

Patterson teaches:

the first information entity including a framework comprising a digital copy of a physical form, and the second information entity includes an overlay having predefined form fields corresponding to the structure of the framework [paragraph 0033] [form overlay with digital form linked to physical form]

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method of document display and form creation in Chalecki with the method of form validation and digital signatures in Daconta with the method of forms overlays in Patterson.

This combination would have been useful to allow the user to associate an overlay with an existing form.

Claim 3:

Chalecki teaches: *The system according to claim 1, wherein the second information entity is an XML-file* [col. 7, lines 34-59] [data files can be separate].

Claim 4:

Chalecki teaches: *The system according to claim 1, wherein the first information entity is an HTML---file* [col. 8, lines 17-57] [contains an HTML file].

Claim 5:

Chalecki teaches: *The system according to claim 1, wherein the first information entity and the second information entity are mutually different* [col. 8, lines 17-57] [contains an XML file].

Claim 6:

Daconta teaches: *The system according to claim 1, wherein the first information entity and the second information entity are mutually different* [col. 5, lines 4063] [signature is in an XML file].

Claim 7:

Chalecki teaches: *The system according to claim 1, wherein the communication terminal is adapted to display the first and the second information entity by means of a web-browser [col. 1, lines 40-59] [HTML, XML and XSLT used because they can be displayed on a web browser].*

Claim 8:

Chalecki teaches:

A method for administrating at least one electronic document, comprising
[abstract]:

-requesting the electronic document at a communication terminal, wherein the document comprises a first and a second information entity [col. 7, lines 14-32] [one file contains many files, including XML and HTML],

-displaying the first and second information entities in dependence of each other such that they form the electronic document [col. 7, lines 34-59] [data files packaged together "in dependence" of each other],

-providing user-generated information to the second information entity [col. 6, lines 33-45] [provide information about data or forms],

Chalecki fails to teach:

the first information entity including a framework comprising a digital copy of a physical form, and the second information entity including an overlay having predefined form fields corresponding to the structure of the framework,

...

-generating a third information entity comprising information corresponding to at least parts of the framework and overlay of the first and second information entities and the user-generated information,

-making the third information entity unique, and

-transmitting the unique third information entity.

Daconta teaches:

-generating a third information entity comprising information corresponding to at least parts of the framework and overlay of the first and second information entities and the user-generated information [col. 4, lines 14-45] [first, second and third parts are described as shown in the figure, the multiple parts to the document described could be the parts described in Chalecki as well, only with the addition of a signature portion],

-making the third information entity unique [col. 10, line 43 – col. 11, line 36] [add signature to document, where the signature is unique to the document], and

-transmitting the unique third information entity [col. 4, lines 46-59] [document can be separated or stripped and transmitted].

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method of document display and form creation in Chalecki with the method of form validation and digital signatures in Daconta.

This combination would have been useful to allow the user the ability to sign documents electronically.

Chalecki and Daconta fail to teach:

the first information entity including a framework comprising a digital copy of a physical form, and the second information entity including an overlay having predefined form fields corresponding to the structure of the framework,

Patterson teaches:

the first information entity including a framework comprising a digital copy of a physical form, and the second information entity including an overlay having predefined form fields corresponding to the structure of the framework [paragraph 0033] [form overlay with digital form linked to physical form]

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method of document display and form creation in Chalecki with the method of form validation and digital signatures in Daconta with the method of forms overlays in Patterson.

This combination would have been useful to allow the user to associate an overlay with an existing form.

Claim 9:

Daconta teaches: *The method according to claim 8, wherein making the third information entity unique further comprises*

-making the third information entity unique by applying a digital signature [col. 10, line 43 – col. 11, line 36] [add signature to document, where the signature is unique to the document].

Claim 10:

Chalecki teaches: *The method according to claim 8, wherein displaying the first and second information entities further comprises*

-displaying the first and a second information entity such that they are aligned in a predetermined way [col. 11, lines 14-29] [forms are “aligned” in that the schemas don't interfere].

Claim 11:

Chalecki teaches: *The method according to claim 8, wherein the step of displaying the first and second information entities is performed by a web-browser [col. 1, lines 40-59] [HTML, XML and XSLT used because they can be displayed on a web browser].*

Claim 15:

Chalecki teaches: *The method according to claim 8, 9, 10, or 11 wherein the method is stored in a memory in the form of instructions executable by a processing unit of the computer terminal* [col. 26, lines 18-68] [computer with program on it].

Claim 16:

Chalecki teaches: *The method according to claim 15 wherein the memory is an internal memory of the communication terminal* [col. 26, lines 18-68] [computer with program and code stored on it].

Claim 17:

Chalecki teaches: *The system according to claim 1 wherein the communication server, upon request, receives the first and second information entities from the database* [col. 8, line 63 – col. 9, line 4] [the forms can communicate with the database in a bidirectional manner, both storing and retrieving].

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Notice of References Cited.

Response to Arguments

Applicant's arguments with respect to claims 1, 3-11 and 15-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin J. Smith whose telephone number is (571) 270-3825. The examiner can normally be reached on Monday through Friday 8:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on (571) 272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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